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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,619	11/26/2003	Peter Davis	10480033040202	7100
37211	7590	03/10/2004	EXAMINER	
BASCH & NICKERSON LLP 1777 PENFIELD ROAD PENFIELD, NY 14526			PURVIS, SUE A	
		ART UNIT	PAPER NUMBER	
		1734		

DATE MAILED: 03/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/722,619	DAVIS ET AL.
	Examiner	Art Unit
	Sue A. Purvis	1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 32-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 34-44 is/are allowed.
- 6) Claim(s) 32 is/are rejected.
- 7) Claim(s) 33 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 26 Nov 2003 is/are: a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

DETAILED ACTION***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

1. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Koda et al. (US Patent No. 5,984,176) in view of Uchimura et al. (US Patent No. 4,618,392) and Franklin et al. (US Patent No. 5,540,795).

Koda discloses it is known to adhere a label to an electronic component (See Figure 2), but does not give details on how that label is applied.

Uchimura discloses a label feeder with a separator and a roller platform as seen in Figure 5. The rollers are made of Teflon. (Col. 2, lines 31-35.)

Franklin discloses a method of applying labels which includes a detection sensor (95) which determines when a label (13) is at the pick up point. The sensor (95) communicates to the control means (93) to cause the transfer mechanism to pick up the label and transfer it to the article to be labeled. When the label (13) is picked up, the sensor (95) produces a

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signal which is used to start the label producing process so that a new label will be at the pick up point when it is time for the next article to be labeled. Using a sensor like this enables the system to have a faster cycle time. (Col. 10, lines 16-60.)

It would have been obvious to one having ordinary skill in the art at the time the invention was made that a known method of applying a label includes a roller platform as disclosed in Uchimura. Using a roller platform to hold a label is advantageous, because the label can be picked up easily from the platform. A non-stick roller platform prevents the label from sticking to the surface of the rollers and allows the label to be easily removed by the suction head which places the label onto the article to be labeled. Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a control feature into the method of Koda in view of Uchimura to communicate when a label is in the pick up position, because such control schemes in labeling methods is well known in the art. This would prevent the suction head in Uchimura from trying to pick up something that is not there. Furthermore, Franklin uses pick and place control methods and in such methods either the timing of the label advancement must be perfect or the scheme must allow for the stopping and starting of the label supply.

3. The recitation "circuit boards assembled therein" has not been given patentable weight because the claim discloses an "assembly system" which places "labels on circuit boards." Thus the "assembly system" referred to in later portions of the claim only includes the assembly of the label to the circuit and not to the assembly of the circuit board. Furthermore, the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand

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alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Allowable Subject Matter

4. Claim 33 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

5. Claims 34-44 are allowed.

6. The following is an examiner's statement of reasons for allowance:

Applicant filed an Affidavit on 07 July 2003 under 37 CFR 1.131 in the parent case (US Serial No. 09/550,030). This affidavit is sufficient to make the Kuno (JP 11-11446) reference, used in the parent case, and newly discovered reference Kou (US Patent No. 6,027,019) not be considered prior art by the examiner. Without the teachings in Kuno and Kou there is no reason or suggestion for incorporating a labeler into a pick and place machine for electronic components.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Watanabe et al. (US Patent No. 5,713,125) discloses an electronic parts mounting method. Suhara et al. (US Patent Application Publication No. 2002/0167801 A1) discloses an electronic component mounting system which includes a labeler therein.

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Nakatsuka et al. (US Patent No. 5,419,802) discloses an electronic component supplying apparatus. Robinson (US Patent No. 5,937,497) discloses a method for removing parts from a tape. Schroeder et al. (US Patent No. 5,399,228) discloses a label applicator which uses a roller platform.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sue A. Purvis whose telephone number is (571) 272-1236. The examiner can normally be reached on Monday through Friday 9am to 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rick Crispino can be reached on (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sue A. Purvis
Examiner
Art Unit 1734

SP
March 5, 2004